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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,948	06/19/2000	Thomas A. Berson	XERIP013	4758

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EXAMINER

GURSHMAN, GRIGORY

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/596,948

Applicant(s)

BERSON T.

Examiner

Grigory Gurshman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claim 8 is rejected under 35 U.S.C. 101 because "a code segment" not claimed as embodied in computer readable-media is descriptive material per se and is not statutory. The computer program embodied on a computer readable medium is only included in preamble, but is not recited in the claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll (U.S. Patent No. 6,105,131) in view of Debry (U.S. Patent No. 6,314,521 B1).
4. Referring to the instant claims, Carroll discloses a secure server and method of operation for a distributed information system (see abstract and Fig.1). Carroll teaches a user terminal 18 includes an application 26, for example a browser, that is responsive to user input and connects to remote applications across a computer network 14. Keys used for encryption and authentication are managed by built-in key ring organizer 27 in the browser 26 (see Fig.1). Carroll teaches that authentication includes reliably determining the identity of a network device contacting the secure

application (see column 3, lines 19-21). Carroll teaches that the user terminal 18 (FIG. 1) contacts the organization server 66 over the computer network 14 (FIG. 1) and transmits access request and the digital certificate (see column 7, lines 55-60).

5. Referring to the independent claims 1, 8, 11 and 22, the limitation "assigning a digital certificate to a network user" is met by the Certificate Management System, which transmits a digital certificate to the user's personal vault and the process in the personal vault then transmits the new digital certificate to the user's browser (see column 8, lines 37-39). The limitation "receiving a command for operation of a network device and the digital certificate from the network user" is met by the user terminal 18 (FIG. 1) contacting the organization server 66 over the computer network 14 (FIG. 1) and transmitting access request and the digital certificate (see column 7, lines 55-60). The limitation "enabling operation of the network device if the digital certificate of the network user is authenticated" is met by teaching that, if the application server verifies the digital certificate, the user terminal is granted access to the application (i.e. device) - see column 9, lines 1-4. While Carroll teaches the use of the built-in key ring organizer 27 in the browser 26 (in Fig. 1), he does not explicitly teach using a cryptographic key stored in the network device for authenticating the digital certificate of the network user.

6. Referring to the instant claims, Debry discloses a Secure configuration of a digital certificate for a printer or other network device (see abstract and Fig.1). Debry teaches that the printer has a unique encryption key stored in it at manufacturing time. This key is also recorded in a database, securely controlled by a certificate authority (see abstract). This key is used for authentication of a digital certificate (see Fig.1 unit 50).

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Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify the secure server system of Carroll, which uses the digital certificate of a network user for enabling operation of the network device, by having the encryption key stored in the printer (i.e. network device) as taught in Debry. One of ordinary skill in the art would have been motivated to modify the secure server system, which uses the digital certificate of a network user for enabling operation of the network device, by having the encryption key stored in the network device as taught in Debry for use in authenticating (see abstract).

7. Referring to claims 2 ,9 and 27, Derby teaches encrypting and decrypting the message request containing it's serial number (see abstract), which meets the limitation "encrypting/ decrypting of policy information". The serial number is associated with the operation permission of the printer (i.e. usage policy).

8. Referring to claims 3, 10 and 17, Debry explicitly teaches a network device being a printer.

9. Referring to claim 5, 12 and 19, Carroll teaches that the network user is another network device (see Fig.1) - network user is a client (18) connected to the servers (12 and 66) over the network (10).

10. Referring to claims 6, 13, 20, Carroll teaches that the user terminal 18 (FIG. 1) contacts the organization server 66 over the computer network 14 (FIG. 1) and transmits access request and the digital certificate (see column 7, lines 55-60).

11. Referring to claim 7,14, 21 and 23, Carroll teaches using the system for electronic payments and billing functions (see Fig. 3A-B).

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12. Referring to claim 24, it is well known in the art to send the software updates over the network within a secure environment, for example, software updates can be downloaded by authorized users and administrators. One of ordinary skill in the art would have been motivated to receive a software update for the network device and make sure that it is coming from the administrator by verifying the digital certificate of the originating device.

13. Referring to claim 26, Carroll teaches the limitation "command for operation of the network device is re-routed to the second network device..." - see Fig.1. Either the server 12 or the server 66 meet the second network device where the command is re-routed to.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Grigory Gurshman whose telephone number is (703) 306-2900. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 receptionist whose telephone number is (703) 305-3900.

Grigory Gurshman
Examiner
Art Unit 2132

GILBERTO BARRÓN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100